UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,877	09/11/2003	Peter McCullagh	OIC0224US	8772

60975   7590   11/27/2007
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ART UNIT	PAPER NUMBER
4127	

MAIL DATE	DELIVERY MODE
11/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 September 2003*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-38* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *11 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This communication is a First Action Non-Final on the merits. Claims 1-38, as

originally filed, are currently pending and have been considered below.

Claim Objections

2.   Claim 25 is objected to under 37 CFR 1.75 as being a substantial duplicate of

claim 24. When two claims in an application are duplicates or else are so close in

content that they both cover the same thing, despite a slight difference in wording, it is

proper after allowing one claim to object to the other as being a substantial duplicate of

the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

4.   Claims 1-7, 12-30, and 33-38 are rejected under 35 U.S.C. 102(e) as being

anticipated by Hack et al. (US 2003/0187675).

      As per claim 1, Hack et al. discloses "A method comprising:

receiving user-specified information pertaining to one or more business challenges of an organization" (pg. 3, col. 1, ¶ 23; via user may select a business goal such as "reducing operating costs or "lowering working capital" where these business goals are also business challenges);

"identifying one or more predefined business processes that address the one or more business challenges of the organization" (pg. 2. col. 2, ¶ 21; identification of value-added business processes and/or strategies);

"and recommending the one or more predefined business processes to a user" (pg. 3. col. 1, ¶ 23; producing a short list of relevant and value adding business processes where producing a list of business processes is the same as recommending processes specific to a particular business challenge).

Claims 17, 23 and 26 recite equivalent limitations to claim 1 and are therefore rejected using the same art and rationale as set forth above.

As per claim 2, Hack et al. discloses "communicating to the user a list of business challenges commonly experienced by a plurality of companies" (pg. 2, col. 2, ¶ 20; via identify market forces associated with the selected industry sector which may include tight labor markets, shift toward a retail demand focus, and rapidly shifting consumer preferences, where these market forces are challenges that are commonly experienced by a plurality of companies. Specific case examples may also be provided by the system);

"receiving a user-specified ranking of an organization performance with respect to each business challenge in the list" (pg. 3, col.1, ¶ 24; via user may rank relative

importance of each business scenario, where the business scenarios are generated by the system based on business challenges);

"and considering the user-specified ranking when identifying the one or more predefined business processes" (pg. 3, col. 1. ¶ 24; via rankings of importance may help define a set of strategies and/ or processes).

Claims 18, 24, and 25 recite equivalent limitations to claim 2 and are therefore rejected using the same art and rationale as set forth above.

As per claim 3, Hack et al. discloses "receiving user-specified information indicating importance of business challenges within the list to the organization" (pg. 3, col. 1, ¶ 24; via user may rank relative importance of each business scenario, where the business scenarios are generated by the system based on business challenges so the business challenges are ranked along with the associated business scenario);

"And considering the importance of the business challenges when identifying the one or more predefined business processes" (pg. 3, col. 1. ¶ 24; via rankings of importance may help define a set of strategies and/ or processes).

Claim 19 recites equivalent limitations to claim 3 and is therefore rejected using the same art and rationale as set forth above.

As per claim 4, Hack et al. discloses "the list of commonly experienced business challenges is specific to a one of a plurality of functions that is selected by the user for evaluation" (pg. 2, col. 2, ¶ 20; via industry analysis may include defining participants in terms of their function or role. Participants may include a manufacturer, supplier, retailer, etc. The industry analysis identifies market forces associated with each

function or role. Users may choose to view the analysis that is associated with their

specific function or role).

Claim 20 recites equivalent limitations to claim 4 and is therefore rejected using

the same art and rationale as set forth above.

As per claim 5, Hack et al. discloses "maintaining a database of commonly

experiences business challenges associated with the plurality of functions" (Hack pg. 2,

col. 2, ¶ 20; via The information and/or analysis may be derived from databases and

other such sources and pg. 2. col. 1. ¶ 17; via A database may be used by the host

servers to store and retrieve information related to the operation of the host servers

which includes the execution of the strategic management system).

As per claim 6, Hack et al. discloses "maintaining a database of commonly

experiences business challenges associated with specific industries" (Hack pg. 2, col. 2,

¶ 20; via The information and/or analysis may be derived from databases and other

such sources and pg. 2. col. 1. ¶ 17; via A database may be used by the host servers to

store and retrieve information related to the operation of the host servers which includes

the execution of the strategic management system).

As per claim 7, Hack et al. discloses "requesting the user to enter

industry and revenue data associated with the organization" (pg. 2, col. 1; via allow the

user to enter information related to the industry that is of interest to the user and pg. 4,

col. 1. ¶ 33; via requiring user to enter financial information such as annual revenue, on

hand inventory, sales, general and administration expenses).

As per claim 12, Hack et al. discloses "displaying to the user each of the one or more business challenges with at least one of the one or more predefined business processes that addresses said each of the one or more business challenges" (pg. 2, col. 2, ¶ 20; via the system may also display solutions/responses to certain of the identified market factors, where the identified market factors are the business challenges and the solutions/responses are the predefined business processes that addresses the business challenges).

Claim 21 and 27 recite equivalent limitations to claim 12 and are therefore rejected using the same art and rationale as set forth above.

As per claim 13, Hack et al. discloses "allowing the user to view detailed business process information for the at least one of the one or more predefined business processes" (pg. 2, col. 2, ¶ 22; via the user may select for further analysis one or more strategies and/or processes from a list of strategies and/or processes recommended by the system where the user will further describe the business strategies chosen by the user).

Claim 22 recites equivalent limitations to claim 13 and is therefore rejected using the same art and rationale as set forth above.

As per claim 14, Hack et al. discloses "identifying a software product required to implement each of the one or more predefined business processes" (pg. 3, col. 1, ¶ 26; via the system may identify software products).

As per claim 15, Hack discloses "mapping each of the one or more predefined business processes to a corresponding best practice strategy recommendation and a

corresponding best practice functionality recommendation" (pg. 2, col. 1, ¶ 16; via a list

of business scenarios relevant to user, proposed business strategies and objectives,

proposed products and services that meet the business strategies and objectives,

where the business scenarios include the business processes and the products and

services are the functionality recommendations provided by the system);

"And allowing the user to view the corresponding best practice strategy

recommendation and the corresponding best practice functionality recommendation"

(pg. 2, col. 1, ¶ 16; via assist a user in analyzing, where the user must be able to view

the recommendations in order for the system to assist them).

As per claim 16, Hack et al. discloses "allowing the user to view performance

metrics associated with the one or more predefined business processes" (pg. 1, col. 2, ¶

9; via provided with a quantitative value that includes metrics, where the performance

metrics are associated with the business processes that the participant has determined

to be relevant and value-adding);

"and allowing the user to view a success story of a customer who has

implemented at least one of the one or more predefined business processes" (pg. 2, col.

2, ¶ 20; via analysis may also provide case examples, where the case examples would

include success stories of other firms pursuing industry trends that have been presented

by the system).

As per claim 28, Hack et al. discloses " A system comprising:

a memory; and at least one processor coupled to the memory" (pg. 2, col. 2, ¶ 18; via

computer device, where a computer is a system comprising a memory and a

processor),

"the processor executing a set of instructions which cause the processor to

receive user-specified information pertaining to one or more business challenges of an

organization" (pg. 3, col. 1, ¶ 23; via user may select a business goal such as "reducing

operating costs or "lowering working capital" where these business goals are also

business challenges),

"identify one or more predefined business processes that address the one or

more business challenges of the organization (pg. 2. col. 2, ¶ 21; identification of value-

added business processes and/or strategies);

"and recommending the one or more predefined business processes to a user"

(pg. 3. col. 1, ¶ 23; producing a short list of relevant and value adding business

processes, where producing a list of business processes is the same as recommending

processes specific to a particular business challenge).

Claim 35 recites equivalent limitations to claim 28 and is therefore rejected using

the same art and rationale as set forth above.

As per claim 29, Hack et al. discloses "the processor is to receive user-specified

information pertaining to one or more business challenges of an organization by

communicating to the user a list of business challenges commonly experienced by a

plurality of companies" (pg. 2, col. 2, ¶ 20; via identify market forces associated with the

selected industry sector which may include tight labor markets, shift toward a retail

demand focus, and rapidly shifting consumer preferences, where these market forces

are challenges that are commonly experienced by a plurality of companies. Specific

case examples may also be provided by the system);

"receiving a user-specified ranking of an organization performance with respect

to each business challenge in the list" (pg. 3, col.1, ¶ 24; via user may rank relative

importance of each business scenario, where the business scenarios are generated by

the system based on business challenges);

"and considering the user-specified ranking when identifying the one or more

predefined business processes" (pg. 3, col. 1. ¶ 24; via rankings of importance may help

define a set of strategies and/or processes).

Claim 36 recites equivalent limitations to claim 29 and is therefore rejected using

the same art and rationale as set forth above.

As per claim 30, Hack et al. discloses "receiving user-specified information

indicating importance of business challenges within the list to the organization" (pg. 3,

col. 1, ¶ 24; via user may rank relative importance of each business scenario where the

business scenarios are generated by the system based on business challenges so the

business challenges are ranked along with the associated business scenario);

"And considering the importance of the business challenges when identifying the

one or more predefined business processes" (pg. 3, col. 1. ¶ 24; via rankings of

importance may help define a set of strategies and/ or processes).

As per claim 33, Hack et al. discloses "displaying to the user each of the one or

more business challenges with at least one of the one or more predefined business

processes that addresses said each of the one or more business challenges" (pg. 2, col.

2, ¶ 20; via the system may also display solutions/responses to certain of the identified

market factors, where the identified market factors are the business challenges and the

solutions/responses are the predefined business processes that addresses the

business challenges).

Claim 37 recites equivalent limitations to claim 33 and is therefore rejected using

the same art and rationale as set forth above.

As per claim 34, Hack et al. discloses "map each of the one or more predefined

business processes to a corresponding best practice strategy recommendation and a

corresponding best practice functionality recommendation" (pg. 2, col. 1, ¶ 16; via a list

of business scenarios relevant to user, proposed business strategies and objectives,

proposed products and services that meet the business strategies and objectives,

where the business scenarios are the business processes and the products and

services are the functionality recommendations provided by the system),

"and to allow the user to view the corresponding best practice strategy

recommendation and the corresponding best practice functionality recommendation"

(pg. 2, col. 1, ¶ 16; via assist a user in analyzing, where the user must be able to view

the recommendations in order for the system to assist them).

As per claim 38, Hack et al. discloses "allow the user to view detailed best

practice information for the at least one of the one or more best practices" (pg. 2, col. 2,

¶ 22; via the user may select for further analysis one or more strategies and/or

processes from a list of strategies and/or processes recommended by the system where

the user will further describe the business strategies chosen by the user).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 8, 9, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Hack et al. as applied to claims 7 and 28 above in view of SAP.com (2002).

As per claim 8, Hack et al. discloses all of the elements of the claimed invention

but fails to explicitly disclose "assessing an adoption level of an automated technology

by the organization based on the one or more business challenges and the industry and

revenue data".

SAP.com discloses a value calculator that "assesses an adoption level of an

automated technology by the organization based on the one or more business

challenges and the industry and revenue data" (SAP Value Calculators; ¶ 2 and 3; via

value calculators determine your "stage of excellence" by assessing your company's

industry, financial performance, and e-business maturity information and also calculates

how much additional value you can realize by improving your e-business infrastructure,

where the e-business would be improving the infrastructure by using one of SAP's

automated technologies).

Therefore it would have been obvious to one of ordinary skill in the pertinent art

at the time the invention was made to modify the business process valuation tool of

Hack et al. to include the value calculator as taught by SAP because it would provide

another way for the user to determine the best process to implement in their company.

Claim 31 recites equivalent limitations to claim 8 and is therefore rejected using

the same art and rationale as set forth above.

As per claim 9, Hack et al. discloses all of the elements of the claimed invention

but fails to explicitly disclose "the automated technology is at least one of customer

relationship management (CRM), partner relationship management (PRM), and

employee relationship management (ERM)".

SAP.com discloses "automated customer relationship management (CRM)

technology" (mySAP Customer Relationship Management; this section gives a

description of SAP's automated CRM technology that they offer to their customers).

Therefore it would have been obvious to one of ordinary skill in the pertinent art

at the time the invention was made to modify the business process valuation tool of

Hack et al. to include the automated CRM technology as taught by SAP.com because

CRM is a very prominent e-business solution that will contribute to the thriving business

of a company if implemented.

7.   Claims 10, 11, and 32 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hack et al. as applied to claims 1 and 28 above in view of

Spangenberg et al. (US 2004/0260585).

As per claim 10, Hack et al. discloses all of the elements of the claimed invention

but fails to explicitly disclose "estimating benefits that are to be gained by the

organization when the one or more business challenges are successfully addressed;

and communicating the estimated benefits to the user".

Spangenberg discloses a method and apparatus for measuring benefits of

business improvements that "estimates benefits that are to be gained by the

organization when the one or more business challenges are successfully addressed;

and communicating the estimated benefits to the user" (pg. 4, col. 1. ¶ 33; via

determining a cost benefit of having the improvement by performing a profit analysis

after implementing the improvement and comparing it to a profit analysis over a same

time period length using estimated performance information prior to implementation of

improvement, where the benefit calculation is based on estimated performance

information thereby making the benefit calculation an estimate as well).

Therefore it would have been obvious to one of ordinary skill in the pertinent art

at the time the invention was made to modify the business process valuation tool of

Hack et al. to include the estimation of benefits as taught by Spangenberg et al.

because the estimating of benefits will ultimately aid the user in determining which

business process will be of most value to their company if implemented.

Claim 32 recites equivalent limitations to claim 10 and is therefore rejected using

the same art and rationale as set forth above

As per claim 11, Hack et al. discloses all of the elements of the claimed invention

but fails to explicitly disclose "wherein the benefits are estimated using statistical data".

Spangenberg discloses a method and apparatus for measuring benefits of

business improvements that "estimates benefits using statistical data" (pg. 4, col. 1, ¶

33; via profit analysis over a same time period length using estimated performance information, where an analysis using estimated performance data is statistical in nature because of the fact that it is estimated).

Therefore it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the business process valuation tool of Hack et al. to include the "estimate of benefits using statistical data" as taught by Spangenberg et al. because the estimating of benefits will ultimately aid the user in determining which business process will be of most value to their company if implemented.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cooperman et al. (US 2003/0115191) discloses a content provider for customer relationship management or other applications. Sanders et al. (US 2004/0249688) discloses a global integrated improvement planning tool. Hutchins et al. (US 7,246,074) discloses a system and method for identifying skills and tools needed to support a process utilizing pre-defined templates. Walsh et al. (US 2003/0233249) discloses a method and system for enterprise business process management. Young (US 2002/0038217) discloses a system and method for integrated data analysis and management.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice D. Carter whose telephone number is (571)

270-5105. The examiner can normally be reached on Monday-Friday (7:30-5:00) with

First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Lynda Jasmin can be reached on (572) 272-3033. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CDC

/Lynda Jasmin/
Supervisory Patent Examiner, Art Unit 4127